

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** GEORGE T. STEPP and PAUL R. KAYL

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Appeal No. 2000-1363  
Application No. 08/848,374

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ON BRIEF

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Before HAIRSTON, GROSS, and BLANKENSHIP, **Administrative Patent Judges.**

GROSS, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1 through 19 and 21, which are all of the claims pending in this application.

Appellants' invention relates to a computer system and a method of storing sets of configuration settings for the computer in a chronological history file for retrieval by the user. Claim 5 is illustrative of the claimed invention, and it reads as follows:

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5. A computerized system comprising:

a non-volatile memory storing a plurality of configuration settings;

a modification component operatively coupled to the memory to permit changes to be made to the configuration settings; and,

a recordation component operatively coupled to the memory to maintain a chronologically ordered history file of changes previously made to the configuration settings.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Harada et al. (Harada)                      5,497,490                      Mar. 05, 1996

ASUS, PVI-486AP4 User's Manual, 1994, pp. 1-1 to 1-13 and 3-1 to 3-35.

Claims 1 through 19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over ASUS in view of Harada.

Reference is made to the Examiner's Answer (Paper No. 15, mailed February 11, 2000) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 14, filed December 6, 1999) for appellants' arguments thereagainst.

#### **OPINION**

As a preliminary matter, we note that appellants, on page 5 of the Brief, indicate that the claims should stand or fall according to the following groups: (1) claims 1, 2, and 4,

(2) claims 5 through 7, 9, 11, and 12, (3) claims 13 and 14, (4) claims 16 and 21, and claims 3, 8, 10, 15, and 17 through 19 are each to stand alone. We will treat the claims in the groupings suggested by appellants, with claims 1, 5, 13, and 16 as representative of the four groups.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will affirm the obviousness rejection of claims 5 through 7, 9, 11 through 14, 16, and 21 and reverse the obviousness rejection of claims 1 through 4, 8, 10, 15, and 17 through 19.

Appellants argue (Brief, page 7) that ASUS and Harada are not combinable. We, however, find that Harada alone satisfies many of the claim limitations, with ASUS merely being cumulative. Accordingly, we will focus primarily on Harada.

Appellants contend (Brief, page 7) that the references fail to teach all of the claim limitations. Specifically, appellants assert that in ASUS "[t]he only retrievably stored settings are the default settings," and in Harada the I/O adapter configurations referenced by the examiner "do not comprise the entire set of configuration settings for a computer system." We agree with both assertions. However, appellants admit that

Harada's I/O adapter configuration settings are configuration settings, and the claims do not specify an entire set of configuration settings. Instead, each of the independent claims recites "a plurality of configuration settings." Appellants argue (Brief, page 8) that in Harada, "stored system configurations are restored without any input from the user unless no configuration settings consistent with the current computer I/O adapter configurations can be found in stored I/O adapter configurations." Also, appellants state that in Harada "no stored configuration can be selected by the user." As to the configurations being restored without user input, only independent claims 1 and 16 even mention the user. Furthermore, only claim 1 requires user selection of stored settings. Therefore, appellants' argument is only relevant to claim 1 and is discussed with respect to claim 1 *infra*.

Regarding claims 1, 5, and 13, appellants argue (Brief, page 8) that Harada fails to teach or suggest chronologically ordered sets of stored configurations. In addition, appellants contend that Harada stores settings, but not changes made to the settings. We disagree with both arguments.

Harada (column 4, lines 41-44) teaches that whenever a new configuration of unit attachments is formed, corresponding system

configuration information is created. Also, Harada explains (column 4, lines 60-65) that HDD stores plural sets of configuration information, "one set corresponding to the latest configuration #1, and others corresponding to other system configurations (#2, #3, etc.) previously formed and set up." Thus, Harada clearly keeps track of which configuration is the most recent and which configurations were formed previously. Harada further teaches (column 5, lines 23-26) that "[e]ach time the system set up program is run relative to a new system configuration #j . . . the (setup) program creates associated system configuration information #j which is stored in NVRAM 7." Thus, the configuration settings are indexed in order as they are created, or rather, chronologically. As to whether Harada stores changes made to the settings, if each setting is saved with the changes made to the previous setting, then the saving of the settings is the same as the saving of the changes.

For claim 16, appellant contends (Brief, page 9) that ASUS and Harada are not combinable and that claim 16 is therefore allowable. However, nowhere do appellants indicate what claim limitations are lacking from Harada.

Regarding claim 1, Harada discloses (column 3, lines 40-46) a computer with a CPU 13, a storage device HDD 9, a non-volatile

memory NVRAM 7, and a program POST allowing changes to be made to configuration settings (see column 2, lines 37-56). Further, Harada, as explained *supra*, suggests maintaining a chronologically ordered history file. However, Harada fails to teach allowing a user to select one of the plurality of configuration settings. Although Harada does indicate (column 6, lines 57-63) that when no stored configuration information matches the detected configuration settings, user participation is required to setup "new" system configuration, Harada does not detail how the user sets up such "new" configurations. Accordingly, we would have to speculate that the user in Harada selects stored configuration settings in such situations. Likewise, ASUS fails to disclose selection of stored configurations when no match is detected. Consequently, we cannot sustain the rejection of claim 1 and its dependents, claims 2 through 4.

We reach the opposite conclusion as to independent claims 5 and 13. Specifically, as explained *supra*, Harada discloses a computer system with a non-volatile memory storing configuration settings, and a chronologically ordered history file of previous configuration settings, and a program (or modification component) for permitting changes to be made to the configuration settings.

Therefore, we will sustain the rejection of claims 5 and 13 and of the claims grouped therewith, claims 6, 7, 9, 11, 12, and 14.

Regarding claim 16, Harada teaches (column 6, lines 57-63) that when no stored configuration information matches the detected configuration settings, user participation is required to setup a "new" system configuration. Although Harada is not explicit about how the new configuration is determined, the teaching of user participation at least suggests a query to the user for the new configuration setting. Further, as explained *supra*, Harada stores each configuration when a new system configuration is set up. Therefore, we will sustain the rejection of claim 16 and claim 21 grouped therewith.

As to claim 8, appellants contend that Harada does not mention querying whether configuration settings should be reset to the changes most recently made, since the changes most recently made are not stored in Harada. However, we have found that Harada does store the most recently made changes. Nonetheless, Harada teaches changing the configuration setting to the changes most recently made upon a match and searches previous configuration settings when there is a mismatch of the configuration setting with the changes most recently made.

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Therefore, Harada teaches away from the claimed invention, and we cannot sustain the rejection of claim 8.

Claims 10 and 18 recite changing the settings to one of a plurality of presets. However, neither reference discloses plural presets nor selecting from plural presets. Therefore, we cannot sustain the rejection of claims 10 and 18.

As appellant points out (Brief, page 11), claim 15 recites "changing the configuration settings stored on the memory to the changes most recently made upon a mismatch of the configuration settings with the changes most recently made." As explained *supra* with regard to claim 8, Harada teaches changing the configuration setting to the changes most recently made upon a match and searches previous configuration settings when there is a mismatch of the configuration setting with the changes most recently made. Therefore, Harada teaches away from the claimed invention, and we cannot sustain the rejection of claim 15.

Claim 17 recites querying the user whether the configuration settings should be reset to the configuration settings of the current configuration file. However, as argued by appellants (Brief, page 11) Harada automatically resets (without user interaction) to the configuration settings of the current



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configuration file. Therefore, we cannot sustain the rejection of claim 17.

Regarding claim 19, as explained *supra* for claim 1, although Harada does indicate (column 6, lines 57-63) that when no stored configuration information matches the detected configuration settings, user participation is required to setup "new" system configuration, Harada does not detail how the user sets up such "new" configurations. Accordingly, we would have to speculate that the user in Harada selects stored configuration settings in such situations. Consequently, we cannot sustain the rejection of claim 19.

#### **CONCLUSION**

The decision of the examiner rejecting claims 1 through 19 and 21 under 35 U.S.C. § 103 is affirmed as to claims 5 through 7, 9, 11 through 14, 16, and 21 and reversed as to claims 1 through 4, 8, 10, 15, and 17 through 19.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

***AFFIRMED-IN-PART***

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

APG/vsh

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